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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,510	02/16/2006	Jan Buberl	06900128PUS1	1191

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EXAMINER	
BROOKS, KRISTIE LATRICE	
ART UNIT	PAPER NUMBER
1616	

NOTIFICATION DATE	DELIVERY MODE
02/11/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/568,510	BUBERL ET AL.	
	Examiner	Art Unit	
	KRISTIE L. BROOKS	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. Claims 1-14 are pending.

2. Receipt and consideration of Applicants amendments/remarks August 22, 2008 is acknowledged.

3. Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Claim Rejections - 35 USC § 102

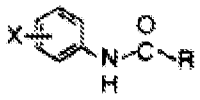
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al., Flower Induction in Asparagus Seedlings by Anilide and Benzamide derivatives, *Journal of Agricultural Food Chemistry*, 40, pg 1692-1694, 1992.

Hara et al. discloses two series of anilides (N-phenylalkanamides) and N-alkylbenzamides induced flowering, germination and emergence in 1-month-old seedlings of *Asparagus officinalis* L (see the abstract and introduction). The compounds

are found to be more effective at flower inducing than the previously evaluated s-triazine and carbamate compounds (see the introduction). The compounds have the structural formula



(see Tables 1 and 2). The method of flower induction involved germinating the seeds in the presence of the compounds and planting the seeds in vermiculite (see the abstract and materials and methods). With regard to the preamble, i.e. a method of treating plants in need of growth promotion, it is the Examiner's position that since the prior art method and the instant method have the same results, i.e. growth promotion, the instant limitation is inherently met.

Response to Arguments

Applicant's arguments filed August 22, 2008 have been fully considered but they are not persuasive.

Applicant argues that the anilide compounds of Hara et al. do not carry a phenyl ring as a substituent on the anilide moiety or, more specifically, a substituted phenyl ring which is located in the 2-position of the anilide moiety and therefore, Hara et al. fail to anticipate any of the present claims.

This argument in not persuasive. It should be noted that instant claim 1 broadly defines A as an "aryl group or 5- or 6-membered heterocycle…, where the aryl *may or may not* have 1,2, or 3 substituents.." and R^2 as "a phenyl or cycloalkyl group which *may or may not* have 1, 2, or 3 substituents" which includes a halogen. Thus, the aryl or

phenyl ring does not have to be substituted. Moreover, Hara et al. do teach the phenyl portion being substituted with halogens (i.e. Cl) (see variable X in Table 1 on page 1693). Thus, the instant compounds are anticipated by Hara et al. as presently claimed and the rejection is maintained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 6,143,745).

Applicant claims a method for treating plants in need of growth promotion, comprising applying to said plants, to the seeds from which they grow or to the locus in

which they grow, a non-phytotoxic, effective plant growth promoting amount of an amide compound having the formula I

A-CO-N R^1R^2.

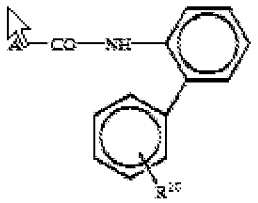
Determination of the scope and content of the prior art

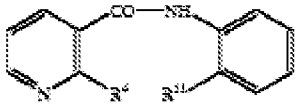
(MPEP 2141.01)

Eicken et al. teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I

A-CO-N R^1R^2

(see the abstract, column 2 lines 63-67 and column 3 lines 1-26). The compositions can preferably contain a compound of formula Ia or Ib





(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The active is present in an amount of 0.1 to 95% (see column 10 lines 63-65). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48).The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active

compound per ha (see column 10 lines 66-67). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[α-(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[α-(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Eicken et al. do not specifically recite the instant method of use. Eicken et al. do not teach an exemplification of the applying a compound of formula I and a strobilurin to plants.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

One of ordinary skill in the art would have been motivated to use the instant compounds in the method instantly claimed because Eicken et al. suggests the compounds are useful in controlling fungi. Although Eicken et al. do not specifically recite treating plants in need of growth promotion, one of ordinary skill can reasonably be assumed that plants in need of treatment against fungi are in need of growth promotion, since if the plants are not treated against the harmful fungi, they would be destroyed.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the instant compounds to help plants in need of growth promotion because by treating the plants against fungal attacks that may damage crops, one of ordinary skill would inherently be increasing plant growth.

Although Eicken et al. do not exemplify the application of a compound of formula I and a strobilurin, it would have been obvious to one of ordinary skill in the art since Eicken et al. suggests that the combination of compounds of formula I and other fungicides such as strobilurins can broaden the spectrum of fungicidal activity. Thus, one of ordinary skill would have used the combination if one wanted to broaden the protection against fungi.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 6,143,745) in view of Asrar et al. (US 2003/0060371).

Applicant claims a method for treating plants in need of growth promotion, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective plant growth promoting amount of an amide compound having the formula I

$$A\text{-}CO\text{-}N\ R^1R^2.$$

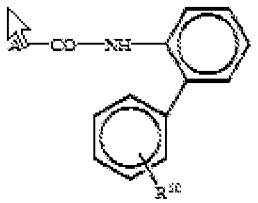
Determination of the scope and content of the prior art

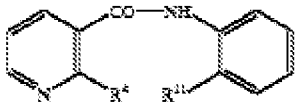
(MPEP 2141.01)

Eicken et al. teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I

$$A\text{-}CO\text{-}N\ R^1R^2$$

(see the abstract, column 2 lines 63-67 and column 3 lines 1-26).The compositions can preferably contain a compound of formula Ia or Ib





(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48).The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active compound per ha (see column 10 lines 66-67). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[α-(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[α-

(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Eicken et al. do not teach the ratio of the amide compound to a strobilurin. Eicken do not teach strobilurin, pyraclostrobin. However, Asrar et al. teach strobilurins, such as pyraclostrobin present in fungicidal compositions in the amount of 0.01 to 95%.

Asrar et al. teach methods of improving the yield and vigor of plants by protection against fungal plant pathogens with a compositions comprising active agents such as strobilurin fungicides, diazole, and triazole fungicides (see the abstract). Examples of strobilurin type fungicides include azoxtstrobin, dimoxystrobin, famoxadone, kresoxim-methyl, metominostrobin, picoxystrobin, pyraclostrobin and trifloxystrobin (see page 5 paragraph 52). The active ingredient can be present in the amount of 0.01 to 95% (see page 17 paragraph 366).

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

One of ordinary skill in the art would have been motivated to use the instant ratio of 20:1 to 1:20 for the compound of formula I and a strobilurin, because Eicken et al. suggests compounds of formula I can be combined with strobilurins. Although Eicken et al. do not teach the amount of strobilurins that present, Eicken et al. suggests the compounds of formula I can be present in the amount of 0.01 to 95% and it is already know in the art that strobilurins can be present in the amount of 0.01 to 95% by weight in fungicidal compositions as suggested by Asrar et al.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the instant ratio, because both the compounds of formula I and strobilurins can be present in various amounts in fungicidal compositions as suggested by both Eicken et al. and Asrar et al. and it is merely process optimization, in which one of ordinary skill in the art would vary the amount of active components necessary in order to achieve success results.

Although Eicken et al. do not teach strobilurin, pyraclostrobin, it would have been obvious to one of ordinary skill in the art to use pyraclostrobin because it is an obvious variation of strobilurins that can be used in fungicidal compositions as suggested by Asrar et al.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

Response to Arguments

Applicant's arguments filed August 22, 2008 have been fully considered but they are not persuasive.

Applicant argues that Eicken et al teach the instant compound and their use for controlling harmful fungi, but do not describe a growth regulating effect. Applicant further points to Examples in the specification (see page 15 and 16) to further establish a growth regulating effect of the instant compounds. Applicant argues that they have defined growth promotion in a specific way which distinguishes the method of the present invention from pesticidal action and Eicken et al. do note teach the growth regulating action of the compounds of formula I.

This argument is not convincing. First, it should be noted that Applicant is broadly claiming “a method for treating plants in need of growth promotion”. Applicant does not provide an explicit definition of what is intended by “growth promotion”, but rather what is intended for "regulating plant growth" (see page 1 and page 9) which is much broader in scope than what is claimed.

Eicken et al. teach the instant compounds are useful for controlling fungi in crops (see the abstract, column 2 lines 63-67, column 3 lines 1-26, and column 10 lines 30-35). Thus, the instant compounds meet the instant limitation of “treating plants in need of growth promotion” since the compounds are capable of reducing or eliminating the presence of fungi, which will ultimately allow affected crops to survive.

Applicant has directed the Examiner's attention to the Examples (see page 15 and 16). The Examples describe onions, grapes and canola seeds treated with the instant compounds. The yield of each crop was increased compared to untreated plots and limited or no fungal disease was present.

This data is not persuasive. Applicant did not provide any data to establish an effect beyond what is already known. The instant compounds increased the yield of the different crops compared to untreated plots and little or no fungal diseases were present. This is expected since the instant compounds are known fungicides. And it would be obvious to one of ordinary skill in the art that an increased yield would result from treatment of a crop susceptible to fungal diseases compared to the untreated crop. Furthermore, Applicant has not demonstrated the crops described in the Examples were affected by anything that would cause it to be in need of growth promotion.

Therefore, Applicant's evidence of nonobviousness was not persuasive and the rejection is maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Mina Haghighatian/
Primary Examiner, Art Unit 1616